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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,513	12/11/2003	Carl J. Kraenzel	LOT920030060US1	9245
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EXAMINER TANG, KENNETH				
ART UNIT		PAPER NUMBER		
2195				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

10/733,513

Applicant(s)

KRAENZEL, CARL J.

Examiner

KENNETH TANG

Art Unit

2195

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-12 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-12 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-2, 6-12, and 27-36 are presented for examination.
2. This final action is in response to the Amendment/Remarks on 7/15/09. Applicant's arguments were fully considered but were not found to be persuasive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-2, 8-10, 27-29, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burger et al. (hereinafter Burger) (US 2003/0220876 A1) in view of Deng et al. (hereinafter Deng) (US 2006/0168395 A1), and further in view of Clark et al. (hereinafter Clark) (US 6,317,797 B2).**

4. *Burger, Deng, and Clark were cited in previous office actions.*

5. As to claim 1, Burger teaches a universal user roaming method, comprising:

providing a computer program having a first set of program code executable on a first WIN32-based operating system (first distinct codes) and a second set of program code

executable on a second non-WIN32-based operating system (second distinct codes, PALM OS or Microsoft Windows CE, etc.) (see Abstract, lines 6-13, page 9, [0118], page 10, [0127]);

setting the first set of program code and the second set of program code to read and write from a common datastore (read/write memory 210 can store first and second distinct codes and may have instructions stored therein which, when executed by the controller, cause implementation of routines/software) (see Abstract, lines 6-13, page 10, [0127]); and

6. In summary of the above citations, an embodiment of Burger teaches a portable electronic device 102, referred to as a "Pocket Vault". The Pocket Vault is a hand-held device like a personal digital assistant (PDA), such as a Palm Pilot, and has an operating system such as Palm OS (or Microsoft CE, depending on the PDA). The Pocket Vault can communicate information with one or more plurality of personal desktop computers. The Palm OS or Microsoft CE are operating systems for a PDA and not for a desktop computer, and Burger (page 2, [0014]) clearly shows that the computer and the electronic device are distinct from each other. For the desktop computers to perform any type of processing, an operating system is required in each of the computers, and these operating systems of the desktop computers are not Palm OS or Microsoft CE but rather an operating system related to a computer (not a PDA device). Read/write Memory 210 can store first and second distinct codes and may have instructions stored therein which, when executed by the controller, cause implementation of routines/software. Therefore, the read/write memory 210 is equivalent to the claimed datastore.
7. However, Burger is silent in storing the content of the common datastore on a removable storage medium that is accessible to only one of the operating systems at any one time, wherein

the first set of program code and the second set of program code provide the operating system functionality to perform common operations on the common datastore. Deng discloses the use of flash memory (or USB Flash Drive, mobile hard disk, semiconductor mobile storage device, zip disk and the like), for example, as a common datastore that is a removable storage medium that is accessible to only one computer/operating system (Windows or non-Windows based) at any one time ([0017]-[0018], [0020]-[0021]). In addition, Deng discloses a universal system interface which interprets and performs the corresponding operations according to commands based on the data from the flash storage device (Abstract, [0032]-[0034]). One of ordinary skill in the art would have known to modify the memory of Burger's apparatus such that it would have a removable storage medium similar to Deng's flash storage memory that is accessible to only one operating system at any one time and serving as a universal system interface which interprets and performs the corresponding operations according to commands based on the data from the flash storage device. The suggestion/motivation for doing so would have been to provide the predicted result of improving the convenience to the user from using memory that is removable and mobile (see last lines of Abstract, [0003], [0007]).

8. Furthermore, Burger in view of Deng is explicitly silent in teaching the first set of program code being a version of a user application that is adapted for execution on the first WIN32-based operating system, the second set of program code being a different version of the application that is adapted for execution on the first WIN32-based operating system, and executing the application from the removable storage medium. However, Clark teaches the use of Microsoft Windows based standard desktop or notebook computer systems along with small handheld computer systems, wherein the small handheld devices perform a reduced/simplified

(different) version of the desktop computer application (col. 2, lines 41-50, col. 10, lines 17-19 and 35-37, col. 11, lines 3-7 and 15-21 and 27-49). In addition, Clark teaches that flash memory 114 can be utilized by both the desktop and handheld computers as a removable storage medium that directly provides functionality to execute certain functions from user applications generally utilized on the road, such as minimal data entry recalculation of spreadsheets, simple editing of word processing without extensive macro capabilities, and so on (lines 1-4 of the Abstract and col. 11, lines 1-11 and 25-29, see Fig. 5, item 114). Finally, there is a common file (common datastore) utilized between the handheld and desktop computer systems for coordination (see Title and col. 16, lines 50-53, col. 11, lines 15-49). One of ordinary skill in the art would have known to modify Burger in view of Deng's system and method such that it would include the features of the first set of program code being a version of an application that is adapted for execution on the first WIN32-based operating system, the second set of program code being a different version of the application that is adapted for execution on the first WIN32-based operating system, and executing the application from the removable storage medium, as taught in Clark. The suggestion/motivation for doing so would have been to provide the predicted result of avoiding synchronization difficulties as well as reducing storage requirements (col. 2, lines 42-50 and col. 11, lines 3-7). Therefore, it would have been obvious to one of ordinary skill in the art to combine Burger, Deng, and Clark to obtain the invention of claim 1.

9. As to claim 2, Clark teaches wherein the first operating system is an operating system for a computer system selected from the group consisting of a desktop (desktop computer) and a laptop (notebook computer) (col. 1, lines 15-18 and 49, col. 2, lines 1-27).

10. As to claim 8, it is rejected for the same reasons as stated in the rejection of claim 1.
11. As to claim 9, it is rejected for the same reasons as stated in the rejection of claim 2.
12. As to claim 10, Burger (see Abstract, lines 6-13) and Clark (col. 16, lines 50-53) teach wherein the first set of program code and the second set of program code are provided within a common directory.
13. As to claim 27, it is rejected for the same reasons as stated in the rejection of claim 1.
14. As to claim 28-29, they are rejected for the same reasons as stated in the rejections of claims 9-10, respectively.
15. As to claim 32, it is rejected for the same reasons as stated in the rejection of claim 1.
16. As to claim 33-34, they are rejected for the same reasons as stated in the rejections of claims 9-10, respectively.

17. Claims 6-7, 11-12, 30-31, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burger et al. (hereinafter Burger) (US 2003/0220876 A1) in view of Deng et al. (hereinafter Deng) (US 2006/0168395 A1), in view of Clark et al. (hereinafter Clark) (US 6,317,797 B2), and further in view of McGuffin (US 7,010,651 B2).

18. Burger, Deng, Clark, and McGuffin were cited in previous office actions.

19. As to claim 6, Deng teaches the method of claim 1, wherein the removable storage medium is a USB flash microdrive or a Zip drive ([0020]). However, Burger and Deng are silent in teaching specifically that other options of removable storage that could be used are an SD-RAM card and a read-writeable compact disc. McGuffin teaches incorporating removable memory storage that could include magnetic removable storage (e.g., floppy disks, cassette tapes, zip drives, USB hard drives and microdrives; optical removable storage (e.g., CD-R, CD-RW, DVDs, etc.); and solid state removable storage, or devices that have no moving parts (e.g., multimedia cards, memory sticks, SmartMedia cards, CompactFlash and Secure Digital cards) (col. 2, lines 22-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burger in view of Deng to include all the options of using removable storage such as in McGuffin. The suggestion/motivation would have been to provide storage that is preferably easily removable in nature to best facilitate extraction of data stored on the medium for use in other computer systems (col. 2, lines 31-37). Therefore, more options of

convenient removable media provide more choices for a user to determine what is most preferable and convenient for him or her.

20. As to claim 7, Deng ([0020]) and McGuffin (col. 2, lines 22-38) teach wherein the SD-RAM interfaces with a computer system via a USB adapter.

21. As to claims 11-12, they are rejected for the same reasons as stated in the rejections of claims 6-7, respectively.

22. As to claim 30-31, they are rejected for the same reasons as stated in the rejections of claims 11-12, respectively.

23. As to claim 35-36, they are rejected for the same reasons as stated in the rejections of claims 11-12, respectively.

Response to Arguments

24. During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during

prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

25. Applicant's amendment to the Specification has overcome the objection to the Title. The Examiner has withdrawn this objection.

26. Applicant's amendment to the claims has overcome the rejection regarding 35 USC 101. The Examiner has withdrawn these rejections.

27. *In the Remarks, Applicant argues the following points regarding the 35 USC rejection of Burger in view of Deng, and further in view of Clark:*

(1) *Burger fails to teach that its read-write memory contains two versions of the same user application, each of which is executable on a different operating system and executed by the appropriate operating system.*

(2) *In Clark, any applications stored in the flash ROM are applicable only to the handheld computer itself because the flash ROM in the passage of Clark cited by the Office is embedded in the handheld computer. Thus, Clark fails to teach multiple versions, one of which is executable on another device, such as the server.*

(3) *Deng fails to teach that it contains user applications that are executed.*

28. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Applicant argues and focuses on portions of references that were not relied upon to meet the claim limitations. A rejection based on 35 USC 103 was made with the references of Burger, Clark, and Deng, and one of ordinary skill in the art would have known that the combinations of these references would cover the broadest reasonable interpretation of the claim limitations.

29. In summary of the teachings of the cited prior art:

Burger teaches a portable electronic device 102, referred to as a "Pocket Vault". The Pocket Vault is a hand-held device like a personal digital assistant (PDA), such as a Palm Pilot, and has an operating system such as Palm OS (or Microsoft CE, depending on the PDA). The Pocket Vault can communicate information with one or more plurality of personal desktop computers. The Palm OS or Microsoft CE are operating systems for a PDA and not for a desktop computer, and Burger (page 2, [0014]) shows that the computer and the electronic device are distinct from each other. For the desktop computers to perform any type of processing, an operating system is required in each of the computers, and these operating systems of the desktop computers are not Palm OS or Microsoft CE but rather an operating system related to a computer (not a PDA device). Read/write Memory 210 can store first and second distinct codes and may have instructions stored therein which, when executed by the controller, cause implementation of routines/software. Therefore, the read/write memory 210 is equivalent to the claimed datastore.

Deng discloses the use of flash memory (or USB Flash Drive, mobile hard disk, semiconductor mobile storage device, zip disk and the like), for example, as a common datastore that is a removable storage medium that is accessible to only one computer/operating system (non-Windows-based or Windows-32-based such as Windows 2000 or XP, etc.) at any one time ([0017]-[0018], [0020]-[0021]). In addition, Deng discloses a universal system interface which interprets and performs the corresponding operations according to commands based on the data from the flash storage device (Abstract, [0032]-[0034]). One of ordinary skill in the art would have known to modify the memory of Burger's apparatus such that it would have a removable storage medium similar to Deng's flash storage memory that is accessible to only one

operating system at any one time and serving as a universal system interface which interprets and performs the corresponding operations according to commands based on the data from the flash storage device. The suggestion/motivation for doing so would have been to provide the predicted result of improving the convenience to the user from using memory that is removable and mobile (see last lines of Abstract, [0003], [0007]).

Clark teaches a system comprising of a standard Windows-based (Microsoft Windows OS) desktop computer system and a small handheld computer system, wherein the small handheld devices perform a reduced/simplified (different) version of the desktop computer application (col. 2, lines 41-50, col. 10, lines 17-19 and 35-37, col. 11, lines 3-7 and 15-21 and 27-49). The handheld device provides functionality that is generally utilized on the road, such as minimal data entry, recalculation of spreadsheets, simple editing of word processing without extensive macro capabilities, etc. (lines 1-4 of the Abstract, col. 11, lines 1-11 and 25-29, see Fig. 5, item 114). On the other hand, the desktop computer system utilizes a "full capabilities" version that would allow for more advanced functionality of the same application program, such as advanced editing of word processing and with extensive macro capabilities, etc. In addition, Clark teaches that flash memory 114 can be utilized by both the desktop and handheld computers as a removable storage medium that directly provides functionality to execute certain functions generally utilized on the road, such as minimal data entry recalculation of spreadsheets, simple editing of word processing without extensive macro capabilities, and so on (lines 1-4 of the Abstract and col. 11, lines 1-11 and 25-29, see Fig. 5, item 114).

30. As to point (1) of Applicant's arguments, Clark is relied upon in teaching a system comprising of a standard Windows-based (Microsoft Windows OS) desktop computer system and a small handheld computer system, wherein the small handheld devices perform a reduced/simplified (different) version of the desktop computer application (col. 2, lines 41-50, col. 10, lines 17-19 and 35-37, col. 11, lines 3-7 and 15-21 and 27-49). The handheld device provides functionality that is generally utilized on the road, such as minimal data entry, recalculation of spreadsheets, simple editing of word processing without extensive macro capabilities, etc. (lines 1-4 of the Abstract, col. 11, lines 1-11 and 25-29, see Fig. 5, item 114). On the other hand, the desktop computer system utilizes a "full capabilities" version that would allow for more advanced functionality of the same application program, such as advanced editing of word processing and with extensive macro capabilities, etc.

31. As to point (2) of Applicant's arguments, it was already shown in point (1) that Clark teaches a user application with multiple versions (full and simplified for desktop and pda, respectively, etc.). Clark's PDA has a PCMCIA card 38 (col. 6, lines 52-59; Fig. 1A) that allows for removable memory cards. Furthermore, Deng teaches that its mobile storage device 10 is used to execute the user-defined commands or data ([0015]; [0031]). The mobile storage device 10 of Deng is mobile and can be used for a plurality of computer systems. Therefore, the combination of Burger, Deng, and Clark teach the broadest reasonable interpretation of this claim limitation.

32. As to point (3) of Applicant's arguments, Deng teaches that its mobile storage device 10 is used to execute the user-defined commands or data ([0015]; [0031]). In addition, Clark teaches user applications that are executed in its flash memory. Thus, the combination of Burger, Deng, and Clark teach the broadest reasonable interpretation of this claim limitation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH TANG whose telephone number is (571)272-3772. The examiner can normally be reached on 8:30AM - 6:00PM, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Meng-Ai An/
Supervisory Patent Examiner, Art Unit 2195

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